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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,785	03/19/2004	Frits Goedegebuur	GC793-3	7768

7590 11/29/2005
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EXAMINER

PATTERSON, CHARLES L JR

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/804,785

Applicant(s)

GOEDEGEBUUR ET AL.

Examiner

Charles L. Patterson, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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Restriction to one of the following inventions is required under 35

U.S.C. 121:

- I. Claims 1-2 and 20-25, drawn to a CBH1 cellulase of SEQ ID NO:5, a detergent and a feed additive comprising the cellulase, a method of treating wood pulp and a method of converting biomass to sugars by use of the cellulase, classified in class 435, subclass 209, class 510, subclass 392, class 241, subclass 28 and class 426, subclass 656.
- II. Claims 1, 3 and 20-25, drawn to a CBH1 cellulase of SEQ ID NO:8, a detergent and a feed additive comprising the cellulase, a method of treating wood pulp and a method of converting biomass to sugars by use of the cellulase, classified in class 435, subclass 209, class 510, subclass 392, class 241, subclass 28 and class 426, subclass 656.
- III. Claims 1, 4 and 20-25, drawn to a CBH1 cellulase of SEQ ID NO:11, a detergent and a feed additive comprising the cellulase, a method of treating wood pulp and a method of converting biomass to sugars by use of the cellulase, classified in class 435, subclass 209, class 510, subclass 392, class 241, subclass 28 and class 426, subclass 656.
- IV. Claims 1, 5 and 20-25, drawn to a CBH1 cellulase of SEQ ID NO:14, a detergent and a feed additive comprising the cellulase, a method of treating wood pulp and a method of converting biomass to sugars by use of the cellulase, classified in class 435, subclass 209, class 510, subclass 392, class 241, subclass 28 and class 426, subclass 656.

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V-XXX. Claims 6-7, drawn to a particular variant of CBH1 cellulase, classified in class 435, subclass 209. There are 26 specific amino acid changes in the instant claims. The groups correspond to the changes. The examiner will examine any change to this amino either by itself or in combination with another change.

XXXI. Claims 8-19, drawn to nucleic acid encoding SEQ ID NO:5, a vector comprising the nucleic acid, a host cell transformed with the vector and a method of producing a CBH1 by using the host cell, classified in class 435, subclass 209,320.1, 252.3 and class 536, subclass 23.2.

XXXII. Claims 8-19, drawn to nucleic acid encoding SEQ ID NO:8, a vector comprising the nucleic acid, a host cell transformed with the vector and a method of producing a CBH1 by using the host cell, classified in class 435, subclass 209,320.1, 252.3 and class 536, subclass 23.2.

XXXIII. Claims 8-19, drawn to nucleic acid encoding SEQ ID NO:11, a vector comprising the nucleic acid, a host cell transformed with the vector and a method of producing a CBH1 by using the host cell, classified in class 435, subclass 209,320.1, 252.3 and class 536, subclass 23.2.

XXXIV. Claims 8-19, drawn to nucleic acid encoding SEQ ID NO:14, a vector comprising the nucleic acid, a host cell transformed with the vector and a method of producing a CBH1 by using the host cell, classified in class 435, subclass 209,320.1, 252.3 and class 536, subclass 23.2.

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It is noted that claims 20-25 are directed to "a CBH1 variant according to claim 1". Claim 1 is not directed to a variant CBH1 but since the claims depend from claim 1 they are grouped with it.

It is further noted that claims 17-19 are directed to "a CBH1 variant" and produce the variant by culturing the host cells of claims 14-16. These host cells do not contain variant CBH1s but since the claims depend from claims 14-16 they are grouped with them.

The inventions are distinct, each from the other because:

The enzymes of groups I-XXX are completely different chemical compounds from the nucleic acids of groups XXXI-XXXIV and are patentably distinct. The different enzymes of groups I-XXX and the different nucleic acids of groups XXXI-XXXIV have different sequences and are structurally different and are therefore patentably distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

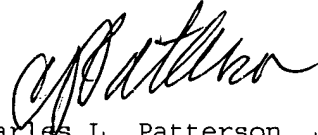
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., PhD, whose telephone number is 571-272-0936. The examiner can normally be reached on Monday - Friday from 7:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached on 571-272-

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0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles L. Patterson, Jr.
Primary Examiner
Art Unit 1652

Patterson
November 17, 2005